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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/064,950

09/03/2002

Erin L. Conner

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

NOTIFICATION DATE

DELIVERY MODE

11/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com

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| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/064,950 | Applicant(s) CONNER ET AL. | |
| | Examiner Jonathan Ouellette | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008 and 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,11,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,11,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 10/29/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/064950 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 3, 4, 7-10, 12-21, and 24-26 have been cancelled; therefore, Claims 1, 2, 5, 6, 11, and 22-23 are currently pending in application 10/064,950.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 5, 6, 11, and 22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wasilewski et al. (US 2002/0105665 A1)**
5. As per **independent Claim 1**, Wasilewski discloses a method of transferring a computer file from a first storage media to a second storage media, comprising: reading the computer file from the first storage media and transferring the computer file into a third storage media; writing the file from the third storage media into the second storage media; and charging a

Art Unit: 3629

transaction fee (Fig.5); and directly establishing a communication link to a portable electronic device through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5, Camera and system direct link), wherein the portable electronic device is in communication with the third storage media through the communication link (Figs. 1-3, 5) (Para 0056, Kiosk can be equipped with peripherals to read digital image files from various sources such as memory cards and portable storage devices like memory sticks – such device require equivalent ports as claimed – and thus would be equivalent to the claimed general peripheral).

6. Wasilewski fails to expressly disclose wherein the transfer of the computer file from the first storage media is controlled by the portable electronic device.
7. However, Wasilewski does disclose the ability to connect and receive data from a wide variety of peripheral devices (portable devices) through a variety of ports included in the system (Figs. 1-3, 5).
8. Furthermore, the Applicant discloses that portable electronic devices commonly collected and transferred digital images at the time the invention was made (Para 0002 – Related Art)
9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the transfer of the computer file from the first storage media is controlled by the (a) portable electronic device, as disclosed by the Applicant in the system disclosed by Wasilewski, for the advantage of providing a method of transferring a computer file from a first storage media to a second storage media, with the ability to increase usability of the system by providing multiple ways of transferring data into the system (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Art Unit: 3629

10. As per Claim 2, Wasilewski discloses wherein the second storage media is paper (Figs. 1-3, 5).
11. As per Claim 5, Wasilewski discloses establishing another communication link over a computer network to a remote computer, wherein the second storage media is controlled by the remote computer and is in communication with the third storage media over the computer network (Figs. 1-3, 5).
12. As per Claim 6, Wasilewski discloses wherein the computer network is the internet (Figs. 1-3, 5; Para 0009 and 0011).
13. As per Claim 11, Wasilewski discloses determining a transaction type, wherein the first storage media and the second storage media are identified according to the determined transaction type (Figs. 1-3, 5).
14. As per **independent Claim 22**, Wasilewski discloses a system for transferring a computer file from a first storage media, the system comprising: a sheet media (F1-3, 5, Printed Hardcopy) distribution device for distributing a sheet storage media, the sheet media distribution device configured to distribute both blank and information carrying sheet media (Fig.5, Printed Hardcopy – Blank if file is blank); an electronic media distribution device for distributing a portable electronic media, the electronic media distribution device configured to distribute both blank and information carrying electronic media (Fig.5, File stored on desired storage media – Blank if file is blank); a first media read/write interface for coupling to the first storage media; a payment interface for accepting payment for a transaction in which the computer file is transferred from the first storage media to the sheet storage media or the electronic storage media (Figs. 1-3, 5); and a portable electronic device interface,

Art Unit: 3629

wherein the portable electronic device interface directly establishes a communication link through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5, Camera and system direct link) and, wherein the portable electronic device is in communication with the sheet storage media or the electronic media through the communication link (Figs. 1-3, 5; Para 0056, Kiosk can be equipped with peripherals to read digital image files from various sources such as memory cards and portable storage devices like memory sticks – such device require equivalent ports as claimed – and thus would be equivalent to the claimed general peripheral).

15. Wasilewski fails to expressly disclose wherein the transfer of the computer file from the first storage media to the sheet storage media or the electronic storage media is controlled by a portable electronic device connected to the portable electronic device interface.
16. However, Wasilewski does disclose the ability to connect and receive data from a wide variety of peripheral devices (portable devices) through a variety of ports included in the system (Figs. 1-3, 5).
17. Furthermore, the Applicant discloses that portable electronic devices commonly collected and transferred digital images at the time the invention was made (Para 0002 – Related Art)
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the transfer of the computer file from the first storage media to the sheet storage media or the electronic storage media is controlled by a portable electronic device connected to the portable electronic device interface, as disclosed by the Applicant in the system disclosed by Wasilewski, for the advantage of providing a method of transferring a computer file from a first storage media to a second storage media,

Art Unit: 3629

with the ability to increase usability of the system by providing multiple ways of transferring data into the system (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

19. As per Claim 23, Wasilewski discloses wherein the sheet storage media is paper and the sheet media distribution device is a digital photocopier (Figs. 1-3, 5).

Response to Arguments

20. Applicant's arguments filed 10/3/2008, with respect to Claims 1, 2, 5, 6, 11, and 22-23, have been considered but are not persuasive. The rejection will remain as NON-Final, based on the cited prior art.
21. The Applicant's arguments are addressed in the revised/clarified rejection above.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

Art Unit: 3629

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

November 14, 2008

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629